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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,345	02/28/2002	W. Wistar Rhoads	10961133-8	8093

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

HSIEH, SHIH WEN

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,345

Applicant(s)

RHOADS ET AL.

Examiner

Shih-wen Hsieh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-38 and 46-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-38 and 46-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8-20-04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Response to Amendment**Double Patenting**

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 32 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 5,914,734 ('734). Although the conflicting claims are not identical, they are not patentably distinct from each other because both cases deal with a reproducible quantity of servicing fluid applied to a print head through a wiper. Below is a table of claims comparison to indicate their obviousness:

<u>10/085,345</u>	<u>5,914,734</u>
32. (Original) An inkjet print head cartridge comprising a container of ink, an area having orifices through which	5. A system for servicing a portion of an inkjet printer having a print head, comprising: <u>a servicing fluid</u>

<p>ink is ejected from said container during printing, a reservoir of print head servicing fluid matched for use with said ink and an applicator for applying a reproducible quantity of said servicing fluid onto a print head wiper which wipes said orifices during relative movement of said print head and wiper.</p>	<p><u>reservoir; a print head wiper; means for releasing a predetermined amount of said servicing fluid from said reservoir onto said wiper;</u> a wiper scraper; means for sequentially moving said wiper from a first location where said wiper engages said means for releasing to receive said predetermined amount of servicing fluid to a second location remote from said first location and said means for releasing, where said wiper engages said print head to transfer said predetermined amount of said servicing fluid onto and wipe unwanted accumulations from said print head, to a third location, remote from said print head and from said first location, said wiper engaging said scraper at said third location to remove unwanted accumulations from said wiper; and a filament releasably positioned in said servicing fluid at said reservoir to retain a <u>reproducible quantity of treatment</u> fluid thereon over a given length of filament and said means for moving said wiper also removing said filament from said reservoir and moving said filament into contact with said print head, thereby transferring a reproducible amount of said servicing fluid to said print head.</p>
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In viewing the table above, the subject matters and limitations of the instant application are obvious over those in the patent ('734). Specifically, the "applicator for applying a reproducible quantity of said servicing fluid onto a print head wiper" in the instant application is equivalent to "means for releasing a predetermined amount of said servicing fluid from said reservoir onto said wiper" in patent ('734).

3. Claim 33 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 5,914,734 ('734). Although the conflicting claims are not identical, they are not patentably distinct from each other because both cases deal with a reproducible quantity of servicing fluid applied to a print head through a wiper. Below is a table of claims comparison to indicate their obviousness:

<u>10/085,345</u>	<u>5,914,734</u>
33. (Original) The cartridge of Claim 32, wherein said servicing fluid is impregnated in a porous material filling said reservoir.	8. The system of claim 5, wherein said servicing fluid reservoir comprises a tape impregnated with said servicing fluid.

A porous material in the instant application can be a tape as that in the patent ('734) to hold the servicing liquid.

4. Claim 34 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 5,914,734 ('734) in view of Burke et al. (US Pat. No. 5,300,958). Burke et al. teach a cleaning solution similar to the servicing fluid claimed in the patent ('734) and is also used to help cleaning the print head through a wiper device.

The device of Rotering et al. (patent 5,914,734) DIFFERS from claim 34 in that it does not teach:

wherein said applicator comprises a wick in fluid communication with said porous material, said wick having a fluid dispensing surface positioned for applying said fluid to a wiper which subsequently wipes said orifices.

Burke et al. teach in their fig.7 a cleaning solution chamber (85) contains cleaning solution, impregnated in a primary absorbent member (94), which has a portion (102) sticking out from an opening (91) so as to contact a wiper (78) transferring the cleaning solution to the wiper, refer to col. 8, lines 12-61. Notes: Burke et al.'s (102) corresponds to the applicator in claim 34 of the instant application.

Therefore it would have been an obvious matter that the "means for releasing a predetermined amount of said servicing fluid from said reservoir onto said wiper" in patent ('734) can be in a form as that taught by Burke et al. with only expressed in a broad sense.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being obvious over Rotering et al.

The applied reference has a common assignee (H&P) with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the

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reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2). Both cases deal with using a servicing fluid/cleaning solution to help cleaning a print head through a wiper device.

In regard to:

Claim 35:

The device of Rotering et al. DIFFERS from claim 35 in that it does not teach: wherein said wick has substantially greater capillary attraction force than said porous material.

In order for the cleaning solution/servicing liquid to go to the tip of the applicator/"means for releasing a predetermined amount of said servicing fluid from said reservoir onto said wiper", the capillary attraction force of the applicator/"means for releasing a predetermined amount of said servicing fluid from said reservoir onto said wiper" should have been greater than that of the porous material impregnated in the reservoir containing the servicing fluid/cleaning solution, such that the servicing fluid/cleaning solution is able to flow to the tip of the applicator/"means for releasing a predetermined amount of said servicing fluid from said reservoir onto said wiper due to the capillary force difference.

Claim 36:

The device of Rotering et al. DIFFERS from claim 36 in that it does not teach: wherein said porous material is an open cell rigid foam block.

Whether the porous material is open cell or close cell is a select material.

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Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to select a porous material, since it has been held to be within the general skill of a worker in the art to select an open cell porous material on the basis of its suitability for the intended use, refer to MPEP 2144.07.

Claims 37 and 38:

wherein said cartridge is refillable (claim 37).

wherein said cartridge is disposable (claim 38).

Rejection:

Whether the cartridge is refillable or disposable can be considered as the manner of using the cartridge, and carries little patentable weight, refer to MPEP 2114, or *In re Malcolm*, 129 F.2d 529, 54 USPQ 235 (CCPA 1942).

Claims 46-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/859,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because both cases deal with a reproducible quantity of servicing fluid applied to a print head through a wiper.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Below is a table of claims comparison to indicate their obviousness:

<u>10/085,345</u>	<u>09/859,692</u>
46. (Original) A method of servicing an inkjet print head comprising applying a	1. A wet wiping system for a print head having an orifice plate, comprising: a

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<p>reproducible quantity of servicing fluid to said print head by causing mutual movement of said print head and a resilient fluid applicator and wiping said print head to remove said fluid from said print head.</p> <p>47. (Original) The method of Claim 46, comprising moving said print head to engage said applicator.</p> <p>48. (Original) The method of Claim 47, comprising engaging a flexible applicator by contact with said print head to release said fluid onto said print head.</p>	<p>moveable container having a reservoir of treatment fluid disposed therein; a block of porous material disposed within said container for absorbing by capillary action said reservoir of treatment fluid; <u>another block of porous material partially disposed within said container and extending outwardly therefrom a sufficient distance to facilitate transfer of treatment fluid to the orifice plate when said container and printhead move relative to one another</u>; said another block of porous material having substantially greater capillary action than said block of porous material so that a distal end portion of the another block is continuously supplied with treatment fluid from said reservoir for facilitating the transfer of treatment fluid to the orifice plate; and a wiper mounted adjacent said moveable container for engaging the orifice plate when said moveable container and print head move relative to one another; said movable container and print head moving a sufficient distance relative to one another in at least one relative axes so that a sufficient amount of the treatment fluid from said distal end portion of a transfer element is transferred to the orifice plate for transporting dried print head residue therefrom as said wiper engagingly travels across the orifice plate; and wherein said block of porous material is a block of open cell foam that substantially fills said container.</p>
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Claims 46-48 of the instant application are method claims, while claim 1 of co-pending application 09/859,692 is apparatus claim. Although co-pending application

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does not claim method claims, however, since both cases deal with a treatment fluid/servicing fluid used to apply to a print head through a wiper device or directly from an applicator associated with the treatment fluid/servicing fluid to the print head so as to help a wiping action, therefore, the method steps in the method claims are deemed to be made obvious by the functions of the structure in the combination as discussed in the apparatus claim 1. Notes: From the table above, the step of applying a reproducible quantity of servicing fluid to the print head in the instant application is obvious over that in the co-pending application, and the "resilient fluid applicator" in the instant application corresponds to the bold-underlined portion in patent ('514).

7. Claim 49 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 5,905,514 ('514). Although the conflicting claims are not identical, they are not patentably distinct from each other because both cases deal with a reproducible quantity of servicing fluid applied to a print head through a wiper. Below is a table of claims comparison to indicate their obviousness:

<u>10/085,345</u>	<u>5,905,514</u>
49. (Original) The method of Claim 47, comprising moving a flexible applicator by contact with said print head to cause said applicator to apply said fluid onto a wiper and moving said print head with respect to said wiper to wipe said print head.	4. The system of claim 3, wherein said printer further comprises a reciprocally moveable carriage for carrying the print head, said carriage being moveable between a first limit and a second limit of travel along a guide rod wherein said applicator is mounted for movement on said guide rod to apply treatment fluid

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	to said wiper as said applicator is moved along said rod by contact with said carriage.
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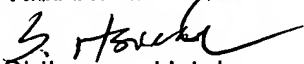
The treatment fluid in the patent ('514) is the servicing fluid in the instant application.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shih-wen Hsieh whose telephone number is 571-272-2256. The examiner can normally be reached on 7:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Talbott can be reached on 571-272-1934. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHIH-WEN HSIEH
PRIMARY EXAMINER


Shih-wen Hsieh
Primary Examiner
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SWH

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Nov. 23, 2004